

Notice of Allowability

Application No.

08/976,820

Examiner

Daniel Zirker

Applicant(s)

LEIBER ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to RCE filing of 6/28/04 with Response.
2. ☒ The allowed claim(s) is/are 20-33.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☒ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☒ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1300-
1700

Daniel Zirker

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1. The Examiner notes that the only drawings in the application appear to be those which accompanied the priority document and therefore applicants are required to submit a suitable set of formal drawings with their next response.

2. The following is an examiner's statement of reasons for allowance:

The Examiner has decided in view of the Lühmann Declaration submitted May 29, 2003 together with applicants' response accompanying their RCE filing of June 28, 2004 that the application is in condition for allowance, notwithstanding the fact that there have been two adverse Board decisions against applicants. They further note that the Lühmann Declaration, which was not timely filed so as to be considered by the Board when making their latest decision in the Rehearing, presents convincing arguments with respect to the non obviousness of the claimed inventions in view of the relied upon prior art combination of record. For instance, at paragraph No. 9 of the Declaration, the declarant states that "I do not believe that providing an appropriate number of grip tabs would have been inferred or would have been well within the ambit of one of ordinary skill in the art." He continues on in his traversal of the prior art combination of Lühmann taken in view of Cole since (as stated in Paragraph 12) "the tabs of Lühmann function to

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remove residue not towards releasing the bond between an object and a substrate. In fact,, one of ordinary skill in the art would have read the Lühmann reference to be at best rather ambivalent about the need for any tabs, much less multiple tabs that:" wherein he quotes column 2 line 57 - column 3 line of the Lühmann reference, which has been extensively relied upon by the Examiner. In paragraph No. 13 he simply states that "the Board misapprehended that one of ordinary skill in the art would 'infer' that grip tabs can be provided to each and every side of the tape". In paragraph No. 16 he continues on with his analysis of the relied upon prior art of passages in Lühmann with the statement that "none of these disclosures would 'infer' to one of ordinary skill in the art to use multiple tabs equaling the number of edges, or to supply grip tabs for each and every edge.

Clearly, the person of Lühmann relied upon by the Board is only talking about the design of a single tab on a single edge". Even if the applicants rely upon the teaching of Example 8 which is the sole place in Lühmann that discloses any embodiments having more than one tab, i.e., paragraph No. 16 simply states that "this disclosure only serves to cement the fact that there are fewer tabs than edges and that what constitutes a 'tab' in the Lühmann reference is used to remove residue and is not directed towards releasing the bond between an object and the substrate."

It is again to be noted that, e.g. applicants' claims require the presence of a polygon (which inherently has at least three sides) and "the same number of grip tabs". Additionally, with respect to claim 27 and its dependent claims, the prior art combination of record as pointed out by applicants in their June 28, 2004 response, (e.g. page 5, next to last paragraph) states that "while the combination of Lühmann and Cole may suggest a circular shape adhesive section, the combination of Lühmann and Cole does not teach or suggest the provision of a single grip tab surrounding a circular shaped adhesive core" as required by claim 27. In summary, the Examiner now believes that what applicants state (Response, page 7, top paragraph) that "what a person having ordinary skill in the art would clear understand from Lühmann at column 2, line 65 to column 3, line 1 is that Lühmann is describing the formation of a single grip tab on a single edge of the quadrangle like folding a piece of non-adhesive material around the edge". Finally, while with hindsight applicants' invention may look simple to one of ordinary skill, yet the fact must be realized that the prior art combination of record fails to either teach or infer the claimed invention without the added assist of hindsight.

Any comments considered necessary by applicants must be submitted no later than the payment of the issue fee and, to

avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (571) 272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (571) 272-1478. The fax phone number for this Group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Dzirker:cdc

October 25, 2004